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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,113

06/24/2002

Masayuki Hataniaka

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01/25/2006

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EXAMINER

ARANI, TAGHI T

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/069,113	HATANAKA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Taghi T. Arani	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-18 have been examined and are pending.

### **Response to Arguments**

2. Applicant's arguments filed 10/21/2005 have been fully considered but they are not persuasive.

Applicant has argued that the Hasebe et al reference does not disclose "a user information hold unit for identifying a user of a recording device, page 12, paragraph 4 of the REMARKS. Applicant further has argued that Hasebe et al. does not disclose a control unit controlling operation of the recording device by referring to protection information to restrict access to the encrypted data, page 13, second paragraph of the REMARKS. The Examiner disagrees for the following reasons.

Hasebe et al. teach (col. 3, lines 47-56) a personal key generating unit (i.e. a user information hold unit for identifying a user of a recording device" which generates a user's personal key using user's personal number and that the decrypting circuit 93 (i.e. a control unit) decrypts the permission information 72 from the software storage medium 71 based on the personal key 81.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-5 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art of record, Hasebe et al. US (5,392,351, hereinafter “Hasebe”) in view of Lang (US 5,191,611).

Regarding claim 1: Hasebe discloses a recording device detachably attachable to a reproduction apparatus reproducing and outputting encrypted content data (Hasebe: Col 2, lines 10-15 & lines 27-29), for receiving and recording said encrypted content data therein (Hasebe: Abstract & Col 2, lines 27-29), comprising:

a data input/output unit allowing external data communication; (Hasebe: Col 3, lines 54-56).

a first storage unit receiving said encrypted content data from said data input/output unit for storage; (Hasebe: Col 3, lines 54-56)

a user information hold unit (Hasebe et al., Col. 3, lines 47-56, i.e. personal key generating unit) holding first user ID data provided to identify a user of said recording device; (see also, Hasebe, Figure 2 and associated text, items 13 and 31) a protection information memory unit holding protection information (Hasebe: Col 5, lines 40-45);

a control unit controlling an operation of said recording device, said control unit referring to said protection information to restrict external access to said encrypted content data held in said first storage unit. (Hasebe: Col. 3, lines 47-56, i.e. the decrypting circuit 93, see also, Col 10, lines 50-59 & Col 11, lines 11-19).

Hasebe does not disclose the protection information updatable in response to a result of comparing externally provided user information with said first user ID data.

However, Lang teaches a method to distribute content to different recipients (Lang: Abstract) where he teaches comparing stored users information with the user information supplied by a personal access device (PAD) to authorize the updating of user information upon successful authorization (Lang: Col 12 lines 36-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of protection information after successful authorization is provided. One of ordinary skill in the art would have been motivated to perform such a modification to provide higher flexibility for the users by enabling a subscriber to change the information concerning his authorization to limit or expand his usage (Lang: Col 12, lines 36-58).

Regarding Claims 2, 15 and 17: Hasebe doesn't disclose the device of claim 1, wherein said control unit allows said user ID data to be changed when externally provided user information and said first user ID data match. However, Lang teaches a method to distribute content to different recipients (See Abstract) where he teaches comparing stored users information with the user information supplied by a personal access device (PAD) to authorize the updating of user information upon successful authorization (Lang col. 12 lines 36-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of protection information after successful authorization is provided. One of ordinary skill in the art would have been motivated to perform such a modification to provide higher flexibility for the users by enabling a subscriber to change the information concerning his authorization to limit or expand his usage (Lang col. 13 lines 29-44).

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Regarding claim 3: Hasebe doesn't disclose The device of claim 2, wherein said control unit allows said protection information and said user ID data to be changed when said user information hold unit does not have said first user ID data registered therein. However, Lang teaches a method to distribute content to different recipients (See Abstract) where he teaches comparing stored users information with the user information supplied by a personal access device (PAD) (Lang col. 12 lines 36-58) and when the user information is not registered enabling the PAD to change user information. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the updating of content information when the user information is not registered in the system yet (Lang: Col 14, lines 5-21). One of ordinary skill in the art would have been motivated to perform such a modification to provide limited access to temporary users or give new users the opportunity to try the system before purchase (Lang col. 14 lines 5-21).

Regarding claim 4: The device of claim 1, wherein said protection information memory unit includes a first protection information memory unit (1520) holding first protection information included in said protection information for restriction on access to said recording device itself, (Hasebe: Col 9, lines 34-45) and said control unit is driven by said first protection information to prohibit additionally recording new encrypted content data in said first storage unit. (Hasebe: Col 9, lines 46-59).

Regarding claim 5: The device of claim 1, wherein: said protection information memory unit includes a first protection information memory unit holding first protection information included in said protection information for restriction on access to said recording device itself; (Hasebe: Col 10, lines 26-40); and

said control unit is driven by said first protection information to prohibit erasing new encrypted content data in said first storage unit. (Hasebe: Col 9, lines 41-59 / the content is unrewritable or write-only storage medium is used)

regarding claims 13 and 14: Hasebe discloses the device of claim 1, further comprising a second storage unit (1500) holding license information data corresponding to said encrypted content data, respectively, and required for reproducing said encrypted content data (Col 3, lines 26-39) but he doesn't disclose the control unit is driven by a result of comparing second user ID data externally provided with first user ID data held in said user information hold unit, to control said second storage unit to provide said license information data to said data input/output unit. However Lang teaches a method to distribute content to different recipients (See Abstract) where he teaches comparing stored users information with the user information supplied by a personal access device (PAD) (Lang: Col 12, lines 36-58) and when there is a match between user information supplied and the user information stored therein allowing access to the content (Lang: Col 12, line 59 through col. 13 line 8 and Col 13 lines 45-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the releasing of license information after the authorization of users by comparing their supplied credentials to the one already exist in the system. One of ordinary skill in the art would have been motivated to perform such a modification to limit and track data retrievals by users, as taught by Lang (Col 13 lines 29-44).

Regarding claim 16: Hasebe discloses the device of claim 14, wherein said content user ID data is said first user ID data held in said user information hold unit when said encrypted content data corresponding thereto is distributed. (Col 7, lines 48-62).

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Regarding 18: The device of claim 1, wherein said first storage unit is semiconductor memory; and said recording device is a memory card. (COI 3, lines 14-26).

4. Claims 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasebe et al. US (5,392,351) in view of Lang US (5,191,611) as applied to claims 1-5 above, and further in view of Shear et al. US (2001/0042043).

Regarding claims 6 and 7: Hasebe discloses the device of claim 5, wherein: said protection information memory unit includes only one information protection unit (Hasebe: items 1 and 13 of FIG.2) and said control unit driven by first protection information to control access to the content (Hasebe: Col 5, lines 39-45) but he doesn't disclose a second protection information memory unit (1540) holding second protection information for restriction on access for each encrypted content data and the control unit is driven by first and second protection information to prohibit erasing encrypted content data.

However Shear discloses a rights management system for protecting the copying and usage of electronic contents (Shear: Page 3, Paragraph 13) where he teaches using more than one set of security control information (information protection unit) and based on the combination of one or more of the security control information deciding access level or permitted operation to the content in the storage device (Shear: Page3, Paragraph 34. & 35 and Page 15, Paragraph 214 & 215).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was to enable the control unit to decide access based on the data in one or more of the information protection units. One would be motivated to do so in order to enable the content to be used based on one or more proposed electronic agreement (Shear: Page 15, Paragraph 214).



Regarding claims 8, 9 and 10: Hasebe discloses a system as modified above, but he doesn't teach the device of claim 6, wherein when an external instruction is received to effect an operation to reproduce said encrypted content data, said control unit controls said first storage unit and is driven by said second protection information to prohibit producing said data input/output unit with encrypted content data held in said first storage unit.

However Shear discloses a rights management system for protecting the copying and usage of electronic contents (Shear: Page 3, Paragraph 13) where he teaches using more than one set of security control information (information protection unit) (Shear: Page 15, Paragraph 214 & 215) and based on the second protection information deciding the access to the content (Shear: Page 16, Paragraph 220).

Therefore it would have been obvious to one ordinary skilled in the art at the time the invention was to enable the control unit to use a second protection information when deciding what operation is permitted on a specific content. One would be motivated to do so in order to enable the control unit to prohibit operations on content based on the device trying to use the content by using the protection information associated with that device (Shear: Page 15, Paragraph 220).

Regarding claim 11: Hasebe discloses a system as modified above, but lacks permitting rewriting on a storage device when there is a match between stored user information and externally provided user information. However, Lang teaches a method to distribute content to different recipients (See Abstract) where he teaches comparing stored users information with the user information supplied by a personal access device (PAD) to authorize the updating of user

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information upon successful authorization (Lang col. 12 lines 36-58). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to enable the rewriting of information to the storage medium after successful authorization is provided. One of ordinary skill in the art would have been motivated to perform such a modification to provide higher flexibility for the users by enabling a subscriber to update or use his information after providing successful authentication (Lang col. 13 lines 29-44).

Regarding claim 12: Hasebe discloses a system as modified above, but lacks permitting rewriting on a storage device when the user ID is not registered in the device. However, Lang teaches a method to distribute content to different recipients (See Abstract) where he teaches comparing stored users information with the user information supplied by a personal access device (PAD) (Lang col. 12 lines 36-58) and when the user information is not registered enabling the PAD to change user information. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the rewriting of content information when the user information is not registered in the system yet (Lang: Col 14, lines 5-21). One of ordinary skill in the art would have been motivated to perform such a modification to provide limited access to temporary users or give new users the opportunity to try the system before purchase (Lang col. 14 lines 5-21).

**Action is Final**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Conclusion**

**6. Prior arts made of record, not relied upon:**

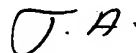
US Patent 6,055,34 to Spies et al. is directed to A system and method for secure purchase and delivery of video content programs over various distribution media, including distribution networks and digital video disks, includes an integrated circuit card (e.g., a smart card, PCMCIA card) which is configured to store decryption capabilities for related video programs. The decryption capabilities are initially kept in a secure store at a video merchant. When a purchaser orders a particular video program, the decryption capabilities for that program are downloaded to the IC card, either at the merchant premises or over a distribution network. The video content program is distributed in encrypted format via the distribution media to the purchaser. The IC card uses the decryption capabilities to at least partly decrypt the video content program without exposing the decryption capabilities.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.  
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1/19/2006



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